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<p>This Opinion is Not Citable as Precedent of the TTAB</p>
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Kimmel & Silverman, P.C.

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Serial No. 76233689

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William H. Murray and Robert E. Rosenthal of Duane Morris & Heckscher LLP for Kimmel & Silverman, P.C.

Henry S. Zak, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).<sup>1</sup>

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Before Quinn, Hairston, and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Kimmel & Silverman, P.C. (applicant) has applied to register LEMONLAW.COM in typed form as a mark for "legal services" in Class 42. The application claims first use and first use in commerce of the proposed mark as of December 1995; and registration on the Principal Register is sought, following amendment, under Section 2(f) of the

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<sup>1</sup> Bradley Cook issued the initial office action on the application. Andrew Lawrence is the current managing attorney for Law Office 108.

Trademark Act, 15 U.S.C. § 1052(f), on applicant's claim that LEMONLAW.COM has acquired the distinctiveness of a mark.

The original examining attorney refused registration of the proposed mark on the ground that it is descriptive of the subject matter of applicant's legal services. See Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). Applicant responded by amending the application to seek registration under Section 2(f). A supporting declaration by applicant's managing partner attests to "at least five years" of "substantially exclusive and continuous use in commerce" of the proposed mark and to the declarant's not being aware of any other uses of LEMONLAW.COM to describe related goods or services.

The second examining attorney then refused registration on the ground that the proposed mark is so highly descriptive that a claim of five years of substantially exclusive and continuous use is insufficient evidence of acquired distinctiveness. In addition, this examining attorney also refused registration under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053 and 1127, on the ground that the proposed mark is only used by applicant in the informational designation [www.lemonlaw.com](http://www.lemonlaw.com), which is merely an address or domain name

and is not used to identify and distinguish applicant's services from similar services of others.

Applicant then argued against the requirement for additional evidence of acquired distinctiveness, noting that its declaration should be accorded greater weight by the examining attorney, in view of the absence from the record of any evidence demonstrating use "in dictionaries, by competitors, or by the public" of the precise term proposed for registration, i.e., LEMONLAW.COM. In addition, applicant argued that, notwithstanding that its proposed mark provides "contact information," such "slogans" have been recognized as marks. The examining attorney was not persuaded by the arguments and issued a final refusal on the ground that the proposed mark, as used, is merely informational (i.e., is merely a website address); and on the ground that the proposed mark is highly descriptive (i.e., a "lemon law" practice is a type of law practice and the ".com" appended thereto is equivalent to "Co." or "Inc." and non-distinctive<sup>2</sup>) and

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<sup>2</sup> The final refusal included a passing reference to "lemon law" as "another generic name for products liability law," but did not set out a genericness refusal. In fact, this reference was followed by the statement "applicant uses the term in a descriptive manner itself in describing its organization as 'The Nation's Largest Lemon Law Firm.'"

applicant's evidence of acquired distinctiveness is insufficient to overcome this refusal.

At this point in the prosecution of the application, the record included: applicant's specimen of use (a newspaper advertisement); applicant's declaration regarding the purported acquired distinctiveness of LEMONLAW.COM; eight excerpts from articles retrieved from the NEXIS database, which the initial examining attorney introduced to establish that "lemon law" is a practice specialty for lawyers; and a definition of ".com" as a "top-level Internet domain used mostly by businesses in the U.S. and Canada ... [and] the first commercial domain name..."<sup>3</sup>

Applicant responded to the final action by filing an appeal to this Board and by requesting reconsideration by the examining attorney. The latter included submission of an amendment to the claim of acquired distinctiveness to rely on, in addition to the previously submitted declaration, applicant's ownership of a registration for the mark 1-800-LEMON LAW, also for legal services; and submission of reprints of web pages accessible at

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<sup>3</sup> We take judicial notice of the following definition of TLD: "(Top-Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the **generic** top-level domains, such as .com, .org, and .net, and the country codes, such as .ca, .uk and .jp." McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001) (emphasis added).

applicant's web site www.lemonlaw.com, which are asserted to show that LEMONLAW.COM is used on those pages not in merely an informational manner but rather as a mark. The appeal was stayed so that the examining attorney could consider the request for reconsideration.

In denying the request for reconsideration, the examining attorney asserted that applicant could not properly rely on its ownership of a registration for the mark 1-800-LEMON LAW for legal services to establish acquired distinctiveness in LEMONLAW.COM for such services, because the two designations are different. In addition, the examining attorney quite clearly argued that the term "lemon law" is not merely descriptive for applicant's legal services but is in fact generic, and therefore not registrable under Section 2(f) or on the Supplemental Register. The addition of ".com" does not alter this result, according to the examining attorney, for all it indicates is that applicant is a commercial entity and the ".com" will only be perceived by consumers as part of an Internet address rather than as an indicator of source. In support of his assertion that the term "lemon law" is generic, the examining attorney introduced a definition of the term from Black's Law Dictionary, reprints of pages from numerous web sites providing information on lemon law

statutes in the various states, and reprints of pages from numerous web sites of law firms that practice in the lemon law field.

As to applicant's arguments against the refusal under Sections 1, 2, 3 and 45, and applicant's submission with its request for reconsideration of reprints of pages from applicant's web site, the examining attorney asserted that "on the specimens of record" applicant only uses LEMONLAW.COM as part of its web site address [www.lemonlaw.com](http://www.lemonlaw.com), and that the reprints submitted with the request for reconsideration have not "formally been introduced" and "cannot be considered." In further explanation, the examining attorney noted that applicant would have to provide a declaration or affidavit, to support use of the web pages as specimens showing use of the proposed mark "at least as early as" the filing date of the application.

Because the request for reconsideration was denied, the Board resumed the appeal and reset applicant's time for filing a brief. Applicant filed its brief and the examining attorney filed a responsive brief. Applicant did not request an oral hearing.

We consider first the refusal of registration under Sections 1, 2, 3 and 45 of the Trademark Act on the ground

that the specimens of use do not show LEMONLAW.COM as a mark but only as an element of what would be perceived as informational matter, i.e., a listing of applicant's www.lemonlaw.com web site address. We agree with the examining attorney that the original specimens filed with this use-based application do not show use of LEMONLAW.COM per se. The specimens, reprints of what appear to be a newspaper advertisement, only show that term embedded in applicant's web site address, in smaller type than much of the copy in the ad, below applicant's phone number and above its mailing address. Under these circumstances, we agree with the examining attorney's conclusion that In re Eilberg, 49 USPQ2d 1955 (TTAB 1999), is controlling.<sup>4</sup>

Applicant attempted to make additional specimens of record to overcome this refusal, but did not properly introduce them into the record. The examining attorney clearly explained this in the office action denying applicant's request for reconsideration, so that applicant could have requested suspension of the appeal to submit the necessary affidavit or declaration. However, applicant failed to make such a request, explicitly, implicitly,

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<sup>4</sup> As applicant and the examining attorney have discussed the decision at length, there is no need for us to recap its facts or rulings of law. Suffice it to say that we agree with the examining attorney's view of the applicability of the decision to the case at hand.

directly or indirectly. Accordingly, we agree with the examining attorney that the substitute specimens were not properly made of record and we have not considered them.

In short, we affirm the refusal of registration under Sections 1, 2, 3 and 45 of the Trademark Act. We now turn to the refusal of registration under Section 2(e)(1) and applicant's attempt to overcome that refusal by showing acquired distinctiveness under Section 2(f).

By amending its application to seek registration under Section 2(f), applicant conceded that LEMONLAW.COM per se is not inherently distinctive. See discussion in Section 1212.02(b) of the Trademark Manual of Examining Procedure (TMEP)(4th ed. 2005). Further, applicant expressly conceded in its request for reconsideration that at least the term "lemon law" is descriptive.

The office actions and responses preceding the filing of applicant's request for reconsideration focused on whether the term "lemon law" is descriptive, the significance of the addition of ".com" to create LEMONLAW.COM, and whether applicant had overcome the refusal under Section 2(e)(1) by successfully showing acquired distinctiveness. In the examining attorney's denial of the request for reconsideration, however, and subsequently in the briefs, much discussion was focused on

whether the term "lemon law" is generic, rather than merely descriptive, and the significance of the addition of ".com" to create LEMONLAW.COM.

Applicant could have argued that it was premature for the examining attorney to make final a refusal under Section 2(e)(1) on genericness grounds when the examining attorney denied the request for reconsideration, notwithstanding that a refusal under Section 2(e)(1) has been maintained throughout prosecution, because applicant had not previously had an opportunity to argue the question of genericness. See TMEP Section 714.03 (4th ed. 2005). However, because applicant did not object to the action denying the request for reconsideration being made final, and because both applicant and the examining attorney have addressed the genericness refusal in their briefs, we consider the issue ripe for decision.<sup>5</sup> Thus, the substantive questions relative to the final refusal under Section 2(e)(1) are whether LEMONLAW.COM is properly refused as generic or is merely descriptive, and if it is the latter, whether applicant has submitted sufficient evidence of acquired distinctiveness to allow for registration.

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<sup>5</sup> The examining attorney essentially has taken the position that genericness is the ultimate form of descriptiveness.

We have already referenced, in general terms, the evidence of record bearing on the refusal under Section 2(e)(1). As we have already referenced the dictionary definition of ".com" submitted by the examining attorney, and taken judicial notice of a definition of "TLD" that explains that ".com" is one of the generic TLDs, below we examine more closely the evidence relevant to the significance of the term "lemon law."<sup>6</sup>

Black's Law Dictionary (7th ed. 1999), at 912, contains the following definition of "lemon law": "1. A statute designed to protect a consumer who buys a substandard automobile, usu. by requiring the manufacturer or dealer either to replace the vehicle or to refund the full purchase price. • Almost all states have lemon laws in effect."

The Nexis excerpts made of record by the examining attorney include articles dated August 13, 2000, October 4, 2000, March 4, 2001 and June 29, 2001, all from The Plain Dealer. These discuss how the state of Ohio's lemon law works and, in one instance, an Ohio Supreme Court ruling on the law. (One article reports, "If the automaker does not

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<sup>6</sup> In considering applicant's proposed mark, "the Board may weigh the individual components" in preparation for considering it as a whole. In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

have a state-approved program, the only way to enforce the lemon law is to get a lawyer and file suit.") Each of the articles includes comments from lawyers who are said to concentrate on or to often handle lemon-law cases, such attorneys being based, respectively in Cleveland, Akron and Dayton. A May 23, 2000 article from the Pittsburgh Post-Gazette reports "There are attorneys who specialize in Lemon Law cases and represent you for free. ... Lemon Law lawyers only take your case if they consider your car to be a true lemon." The May 22, 2000 New Jersey Law Journal reports on the "Lemon Law defense" bar, states that "Lemon Law is a type of work lawyers may turn to" if other aspects of their practice are slow, and notes that "many of the Lemon Law [defense] practitioners also do product liability defense." A November 30, 1999 article in The Tampa Tribune on flood-damaged vehicles includes a quote from a "Richmond, Va., lawyer and lemon-law expert." Finally, the October 1999 issue of Consumer Reports details sources of information on lemon laws and how to obtain "referrals to lawyers who specialize in lemon-law cases."

Web pages retrieved from the Internet by the examining attorney include a web site with "links to lemon law firms across the nation and national lemon law lawyer directories" ([www.krowenlaw.com/lawfirms.html](http://www.krowenlaw.com/lawfirms.html)); a web site

with Lemon Law Summaries and links to individual state Lemon Law Statutes ([www.carlemon.com](http://www.carlemon.com)); and a web site that claims to be "one of the oldest and most trusted Lemon Law information site[s] on the Internet with complete coverage of all Lemon Law Statutes in all 50 states and the District of Columbia" ([autopedia.com/html/HotLinks\\_Lemon.html](http://autopedia.com/html/HotLinks_Lemon.html)), and which includes in its state by state links "Lemon Law Attorney Directories".<sup>7</sup> The web site [www.lemonlawamerica.com](http://www.lemonlawamerica.com) offers visitors "a lemon law case review from one of our lemon law attorneys." The web site of the firm of Krohn & Moss ([www.yourlemonlawrights.com](http://www.yourlemonlawrights.com)) is titled as "Your Source for Lemon Law Information and Help" and asserts that it "has experienced lemon law attorneys" in ten states; and there are reprints from a web site of a North Carolina firm ([www.nclemonlaw.com](http://www.nclemonlaw.com)) which provides access to "A listing of Lemon Law firms in other states..."<sup>8</sup>

When a proposed mark is refused registration as generic, the examining attorney has the burden of proving genericness by "clear evidence" thereof. See In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); see also In re Gould

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<sup>7</sup> This web site also uses the phrasing "Many Lemon Law attorneys will..." and "The Lemon Law attorney can..."

<sup>8</sup> There are a handful of other items in the record, but those that we have discussed above are the most pertinent.

Paper Corp., 834 F.2d 1017, 5 USPQ2d 1110, 1111 (Fed. Cir. 1987). The critical issue is to determine whether the record shows that members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986); In re Women's Publishing Co. Inc., 23 USPQ2d 1876, 1877 (TTAB 1992). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Ginn, supra*, 228 USPQ at 530. Evidence of the public's understanding of a term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers and other publications. See *Merrill Lynch, supra*, 4 USPQ2d at 1143 (Fed. Cir. 1987), and In re Northland Aluminum Products, Inc., 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

As for the class of services involved in this appeal, the examining attorney essentially contends that it is a legal specialty, i.e., the lemon law field, within the broader legal specialty of products liability. Applicant essentially contends that the class of services is "not a

'field of law,' but the rendering of legal services." (Brief, p. 5). Both assessments miss the mark a bit. The examining attorney has focused too much on the proposed mark and on what the record shows to be a specialty of applicant's law practice, and has lost sight of the identification of services. Applicant, on the other hand, draws an artificial distinction when it distinguishes a "field of law" from the rendering of legal services.

Applicant does not actually contest the examining attorney's focus on a *particular* field of legal services, rather than legal services generally, as can be seen from its brief, wherein it states that the "relevant class here is the rendering of legal services to consumers in the *field of products liability*." Brief, p. 5 (emphasis added). Applicant does, however, appear to be arguing that there is a distinction between a field of law in the abstract and rendering of services in that field,<sup>9</sup> because it has concluded that even if "lemon law" is the name of a field of law, it is not a name for the rendering of legal services and cannot therefore be generic for applicant's identified services.

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<sup>9</sup> We find the distinction artificial, for it contemplates that fields of law may be identified by marks as readily as by generic or descriptive terms, and there is nothing in the record to indicate that fields of law are distinguished in this way.

In this case, we find the identification of services in the involved application, i.e., "legal services," to aptly set forth the relevant class or genus of services. Legal services can include, as the record reveals, providing legal information, providing legal representation, or providing referrals to others who may provide legal representation.

The next question is: who are the members of the relevant public for such services, and what will they understand when confronted with LEMONLAW.COM? We conclude that members of the relevant public include lawyers who may be seeking legal information or who may be seeking other lawyers to whom they may refer clients. The relevant public also includes laypersons that may be seeking legal information, legal representation, or referrals.

We find the record sufficient to establish that lawyers and laypersons alike considering the term "lemon law" in conjunction with the class or genus "legal services" will immediately consider it to be the name of a field of law as well as a legal practice specialty. In this sense, the term "lemon law" is generic both for the field and the practice specialty. Thus, we disagree with applicant's contention that "lemon law" is merely descriptive but not generic. The term does not merely

describe an attribute, feature or characteristic of a field of law and practice specialty. Instead, it names the field and specialty. Moreover, the evidence of record reveals that both those in this field of law and members of the public who may be in need of legal services when they have a "lemon," would be familiar with, and have used, "lemon law" as the name of the field and practice specialty.

The fact that there may be many other fields of law and legal practice specialties within the broader class or genus known as "legal services" does not make the term "lemon law" any less generic. In other words, merely because, for example, legal services could also encompass services in the field or practice specialty of criminal law, and "lemon law" would not be a generic term for that field or specialty, does not render the term non-generic for the practice of lemon law, or providing information or referrals in that field. In re CyberFinancial.Net, Inc., 65 USPQ2d 1789, 1791 (TTAB 2002).

Applicant argues that LEMONLAW.COM is a slogan and, in that respect, similar to 1-888-M-A-T-R-E-S-S, the designation at issue in In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). Essentially, applicant contends that the addition of the ".com" TLD to the generic term lemon law should result in a

mark registrable on the Principal Register, just as the addition of "1-888" to "mattress" resulted in a non-generic mark for the applicant in *Dial-A-Mattress*. We, however, find the case at hand distinguishable from *Dial-A-Mattress*, for reasons largely articulated by the Board in *CyberFinancial.Net*, and In re Martin Container, Inc., 65 USPQ2d 1058 (TTAB 2002). See also In re Eddie Z's Blinds and Drapery Inc., 74 USPQ2d 1037 (TTAB 2005).

First, it has been held that compound words may be refused as generic when definitions of the individual terms that are joined to create the compound show that such terms are generic. *Gould, supra*, 5 USPQ2d at 1110.<sup>10</sup> In *Dial-A-Mattress*, the Federal Circuit noted that "'(888)' is not a word" and that 1-888-M-A-T-R-E-S-S is conceptually closer to a phrase than a compound word, so that the *Gould*-type evidence would not be sufficient. *Dial-A-Mattress*, 57 USPQ2d at 1811. Generic terms coupled with a TLD, on the other hand, are considered compound words. See *CyberFinancial.Net* and *Martin Container, supra*. In this case, therefore, we have a compound formed by joining the generic term "lemon law" and the generic TLD ".com." Thus,

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<sup>10</sup> Thus, in such cases, it is not critical that the evidence only shows the elements of the compound, rather than the compound itself, to be generic.

under *Gould*, the examining attorney may carry his burden of proving, by clear evidence, the genericness of LEMONLAW.COM by introducing, as he has, evidence of the genericness of "lemon law" and ".com."

As the Board noted in its recent decision in the *Eddie Z's* case, we are cognizant of the Federal Circuit's ruling in In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004). *Oppedahl* cautions that while the "addition of a TLD such as '.com' or '.org' to an otherwise unregistrable mark will typically not add any source-identifying significance," this "is not a bright-line, per se rule" and that "exceptional circumstances" might yield a different result. *Id.* at 71 USPQ2d 1374. As the Board also noted in *Eddie Z's*, it does not view *Oppedahl* as creating a per se rule that addition of a TLD to an unregistrable term always results in at least a potential mark, i.e., a non-generic compound and, instead, views the *Oppedahl* decision as leaving the door open for registration of combinations of unregistrable terms and TLDs in the exceptional circumstances whereby the combination results in a whole greater than the sum of its parts. *Eddie Z's*, 74 USPQ2d at 1042. As in *Eddie Z's*, we do not find the combination now before us to present such exceptional circumstances.

The Board also explained in *Eddie Z's* another reason why the combination of a generic term with a TLD is not like the coupling of telephone numbers and words that may otherwise be unregistrable, as in *Dial-A-Mattress*. Specifically, the Board noted that *Dial-A-Mattress* involved a mnemonic representing a unique telephone number whereas the combination of a generic term and a TLD can be incorporated into other domain names. *Eddie Z's*, 74 USPQ2d at 1042. Any provider of lemon law legal services should be free to incorporate the generic compound term in its domain name without fear of violating the laws protecting trademarks. *CyberFinancial.Net*, 65 USPQ2d at 1793.

One last point to be considered is that applicant's identification, "legal services," does not state that applicant is utilizing the Internet in rendering its services (e.g., in providing lemon law information or lemon law referrals), but the record is clear that applicant actually does utilize the Internet to promote the availability of its services. Thus, the fact that applicant does not mention the Internet in its identification does not prevent LEMONLAW.COM from being held generic. See *Martin Container*, 65 USPQ2d at 1062.

While we have found applicant's proposed mark to be generic, we now will assume that it is in fact only

descriptive and address the question whether applicant has made sufficient evidence of record to show acquired distinctiveness.<sup>11</sup> While applicant stressed two pieces of evidence of distinctiveness in responding to the examining attorney's office actions, specifically, the declaration of applicant's managing partner and applicant's ownership of a registration for 1-800-LEMON LAW, in its brief it has only argued that the prior registration establishes distinctiveness. We, however, have considered both items.

In *Dial-A-Mattress*, the Federal Circuit considered a declaration of that applicant's counsel, attesting to national advertising of a previously registered mnemonic mark and receipt of one million customer calls over a period of 16 months via various telephone numbers presented as mnemonics. The declaration, however, was held insufficient evidence of acquired distinctiveness because it did not offer direct evidence that customers associated the proposed mark with applicant. *Dial-A-Mattress*, 57 USPQ2d at 1813. However, the prior registration of a mnemonic mark which the Federal Circuit found to be the legal equivalent of the mark proposed for registration was

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<sup>11</sup> Descriptive "TLD marks may obtain registration upon a showing of distinctiveness." *Oppedahl*, 71 USPQ2d at 1373.

found to establish a prima facie case of acquired distinctiveness. *Id.*

In the instant case, we do not find the declaration of the applicant's managing partner sufficient evidence of acquired distinctiveness. As in *Dial-A-Mattress*, it is not direct evidence of distinctiveness. It only invites an inference of distinctiveness based on applicant's claim that it has been using the proposed mark continuously for five years. We do not find the inference warranted. We also do not find applicant's prior registration to establish a prima facie case of acquired distinctiveness. In *Dial-A-Mattress*, the Federal Circuit found two very similar mnemonic marks to be legal equivalents. *Id.* We do not find the current applicant's previously-registered mnemonic mark and its proposed mark LEMONLAW.COM to be legal equivalents, and applicant has not pointed to any decision finding a mnemonic telephone number mark and a domain name proposed as a mark to be legal equivalents. Accordingly, we agree with the examining attorney's conclusion that applicant has not shown that its proposed mark, if considered to be only merely descriptive and not generic, has acquired distinctiveness sufficient to allow it to be placed on the Principal Register.

**Ser No.** 76233689

Decision: The refusals of registration, under Sections 1, 2, 3 and 45 and under Section 2(e)(1), are affirmed.